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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,430	10/21/2003	Brett Allison Taylor	104558-200	3833
7590	02/16/2006			
David C. Jenkins Eckert Seamans Cherin & Mellott, LLC 44th Floor 600 Grant Street Pittsburgh, PA 15219			EXAMINER PRONE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 02/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,430

Applicant(s)

TAYLOR, BRETT ALLISON

Examiner

Christopher D. Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 5,15,25 and 37-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, 16-24 and 26-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/05 10/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of invention 1 and species 1, claims 1-4, 6-14, 16-24, and 26-36 in the reply filed on 12/13/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-4, 6-14, 16-24, and 26-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the contacting member" in line 11. There is insufficient antecedent basis for this limitation in the claim. It is unclear what member the applicant is referring to because multiple members are contacting each other.

In regards to claim 10 on line 4 it is unclear what the applicant means by the recitation "facing generally axially." The term axially is extremely broad and could mean in any direction. Therefore the claim is considered to be indefinite and has been rejected over the art as best understood below

Claim 18 recites the limitation "the other member" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is unclear what other member the applicant is referring to.

In regards to claim 19 the examiner does not understand what the applicant is attempting to claim on lines 4-7. What the applicant means by the recitation requiring the association of the protrusion with one endplate and then reception by the other endplate is unclear. Even more confusing is the recitation that the opening is larger in a rotational direction about the pivot. The claim is considered to be indefinite and has been rejected over the art as best understood below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, and 13, are rejected under 35 U.S.C. 102(B) as being anticipated by USPN 6,129,763 Chauvin et al.

Chauvin discloses the same invention being a vertebral disk prosthesis comprising a member (1) having lateral portions (5) having keyway portions (19) flexibly coupled together through a central portion (7), and an expansion wedge member (2) having a key portion (18) configured to move the lateral members between compressed and expanded states corresponding to the periphery of a vertebral body.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-12, 14, 16-20, 22-24, and 26-33 are rejected under 35

U.S.C. 102(e) as being anticipated by USPN 6,835,206 B2 Jackson.

In reference to claims 1-4, 6, 9, 10, 14, 24, and 28-33, Jackson discloses the same invention being a vertebral disk prosthesis comprising a member (10) having lateral portions (21) and (22), a gripping portion (23), flexibly coupled together through a central portion (16), and an expansion wedge member (12) having an inclined surface (50) configured to move the lateral members between compressed and expanded states corresponding to the periphery of a vertebral body.

In reference to claims 7 and 8 Jackson discloses a threaded fastener (13) connected between the wedge (12) and a member (10).

In reference to claims 11 and 12 Jackson discloses that the wedge portion may comprise a ratchet member for resisting withdrawal movement of the wedge shown in figures 25-31 as members (433) and (451).

In reference to claims 16-20 Jackson discloses pivotally connected top and bottom end plates (21) and (22), a pivot limiter (13) with a central portion (64) attached

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to the other member and a sloped surface (62) for allowing and limiting movement between the endplates and the limiter about a universal pivot.

In reference to claims 22 and 23 Jackson discloses a spacer (13) including a central portion (62) that the lateral portions are movably coupled to.

In reference to claims 26 and 27 Jackson discloses first and second living hinges (10) and (11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 34-36 are rejected under 35 U.S.C. 103 as being unpatentable over USPN 6,835,206 B2 Jackson.

Jackson discloses the invention substantially as claimed and described in detail above. However Jackson does not disclose that a gel bushing is placed between threads (64) and the threaded portion (33) of member (10).

It is common knowledge in the fastener prior art to insert a gel bushing between the threads of a screw and a threaded member for the purpose of reducing friction and forming a solid connection.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a gel bushing at the intersection of threaded member

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(63) and the threaded portion (33) of member (10) in order to form a more secure fit and reduce friction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Prone whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday Through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CDP

Christopher D Prone
Examiner
Art Unit 3738


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